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| 10/073,952 | 02/14/2002 | Norihisa Takayama | 018656-264 | 8703 |

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EXAMINER

THOMAS, ASHISH

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2625

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,952

Applicant(s)

TAKAYAMA, NORIHISA

Examiner

Ashish K. Thomas

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/16/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-15 and 18-21 is/are rejected.
- 7) ☒ Claim(s) 6, 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 3/16/2006 have been fully considered but they are not persuasive.

The applicant states in page 11, lines 6-8 of the Remarks that Powers "fails to teach or suggest at least comparing the sending address input via the sending address input means to the unique email address."

In reply, Powers indeed does not teach a method that compares "the sending address input via the sending address input means to the unique email address." However, the claim rejections below indicate that incorporating Scheussler does in fact teach this method. Also note that the original claims did not have the comparing means present in the amended claims. Therefore, the Examiner had to incorporate Scheussler in his response to the amended claims.

Applicant describes in page 13, line 21 – page 14, line 2 of the Remarks that there is no indication in Soroker that the "list of all recipients includes the sending address."

In reply, Soroker displays a list of all recipients; Soroker does not explicitly point out that sending address and receiving addresses are included in the recipient list. However, please note that the Examiner uses Soroker to simply show an apparatus' ability to display its recipient list to the user. The rejections described below show that Powers and Lytle et al teach what constitutes a recipient list: both the user inputted sending address and the user inputted receiving addresses. Therefore, the

combination of Soroker, Powers, and Lytle et al indicates that the list of recipients displayed include the sending address along with the receiving addresses.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-5, 8, 10-15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication Number 2002/0188683 by Lytle et al in view of U.S. Publication Number 2001/0034849 by Powers and further in view of U.S. Patent Number 6,366,950 by Scheussler et al.

Regarding claim 1, Lytle discloses an e-mail transmission apparatus comprising:

- sending address input means for receiving user input of a sending address; and receiving address input means for receiving user input of a receiving address. (**Paragraph 158, line 7 – paragraph 157, line 2 and table 1** illustrates a means for inputting the sending address and receiving addresses.)
- list creation means for creating a receiving address list that includes at least the receiving address input via the receiving address input means. (**Paragraph 168, lines 3-12** discloses emails are sent to recipients whose email addresses are stored. The act of storing the recipient email

addresses is, in essence, equivalent to the list creation means for creating a receiving address list mentioned in the present application.)

Lytle, however, does not consist of an address adding means which adds the inputted sender address to the receiving address list.

Powers, on the other hand, discloses in **paragraph 118** an apparatus that sends an email to the designated sender of the email. Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Lytle et al with Powers to form an apparatus that sends emails to not only the addresses in the inputted recipient list but also to the inputted address of the sender. The motivation behind incorporating Powers into Lytle et al is to devise a security method that inhibits impersonation of a user's identify as suggested in **Paragraph 117** of Powers.

The combined teachings of Lytle et al and Powers put forth an apparatus that adds an inputted sender email address to the recipient list already consisting of the user entered receiving email addresses.

However, the aforementioned combination of Lytle et al with Powers fails to put forth a device possessing the capability to register a unique email address assigned to the email transmission apparatus nor does it have the capability to add an inputted sender email address when the inputted sender address does not match the registered unique email address.

Scheussler et al, on the contrary, depict in **column 7, lines 21-30** a method that can recognize email impersonators by matching the inputted sender email address with the an ID associated with the sending apparatus. If the inputted sending address does

Art Unit: 2625

not match the unique ID associated with the emailing apparatus, then the email is deemed illicit. Furthermore, **column 3, lines 64-66** in Scheussler's disclosure specifically points out that a user email address is associated with an apparatus identifier. Basically, the above mentioned references illustrate Scheussler's ability to register a unique email address assigned to the email transmission apparatus as well as Scheussler's ability to compare the user inputted email address with the apparatus ID to see if the two match. As stated before, if the inputted sending address does not match the apparatus ID, then the system is notified of the possibility of an unauthorized user. Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Scheussler et al with Lytle et al and Powers to devise an email transmission apparatus, when notified of the possibility of an unauthorized user, adds the inputted sender email address to the receiving address list. The motive behind this suggestion is to inform the actual owner of an email address that his/her email address has been used without his/her knowledge.

Regarding claims 10 and 11, they disclose the same subject matter as claim 1.

Therefore, these two claims are rejected in the same manner as claim 1.

Regarding claims 2 and 12, they adhere to all the limitations expressed in claims 1 and 11 as taught by Lytle et al, Powers, and Scheussler et al. Note that Lytle et al states in **Paragraph 168, Lines 3-12** emails are sent to a number of recipients whose receiving addresses are stored. This action represents the concept of "sending means for sending email based on the receiving address list" stated in the current application.

Regarding claims 3-4 and 13-14, the rejection used for claims 1 and 11 are applicable to these claims as well since both sets of claims disclose the ability to send emails to both the inputted sending address as well as the inputted receiving addresses. Note that claims 3 and 13 describe the ability to send emails to the sending address in parallel with the receiving addresses, while claims 4 and 14 detail the ability to send emails to the sending address independently of the receiving addresses. Both these restrictions are met by the rejection of claims 1 and 11. The combined teachings of Lytle et al, Powers, and Scheussler et al simply form an email transmission apparatus that transmits to the sending address and receiving addresses in the recipient list at one time, thereby supporting the parallel transmission. Furthermore, the combination does not suggest that transmission to an email address is in any way affected by the status of other email addresses in the recipient list, thereby supporting the independent transmission capability too.

Regarding claims 5 and 15, they adhere to the limitations found in claims 2 and 12 according to the combined teachings of Lytle et al, Powers, and Scheussler et al. As previously mentioned, Powers illustrates in **Paragraph 118** a security checking means where an email is send to the user inputted sending address as well. Note that Powers depicts a method of "approving the proof copy" in **Paragraph 118, Lines 9-10**. The "proof copy" mentioned is the email sent to the sending address. Once email is approved, the sender's legitimate identity is established. Once the legitimate identify of sender is established emails can be safely transmitted to the inputted receiving addresses. This reference therefore implies that the sending means sends the email to

the sending address in the receiving address, and then only after a return communication is received thereto, sends the email to the receiving address in the receiving address list.

Regarding claims 8 and 18, they adhere to all the limitations found in claims 1 and 11 according to the combined teachings of Lytle et al, Powers, and Scheussler et al. In fact, Powers states in **Paragraph 118, Lines 6-8** that a "security mechanism" is used to verify the identity of sender, the mechanism constituting of the step of sending a copy of the email to the inputted sender address. The term "security mechanism" emphasizes the safeguarding involved in this process. In that, it would be difficult for the sender to delete the inputted sending email address from the recipient list. As a result, the address adding means adds the sending address to the receiving address list in a format such that it cannot be deleted from the receiving address list.

2. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication Number 2002/0188683 by Lytle et al in view of U.S. Publication Number 2001/0034849 by Powers, U.S. Patent Number 6,366,950 by Scheussler et al, and U.S. Publication Number 2002/0112010 by Soroker et al.

Regarding claims 9 and 19, the combination of Lytle et al, Powers, and Scheussler et al puts forth an email transmission apparatus that adds the sending address to the receiving address list; the sending address is incorporated into the recipient list which already consists of the inputted receiving addresses. However, this combination does not involve a method that displays the addresses contained in the recipient list. Soroker et al, in **paragraph 38, Lines 1-5**, displays a list of all recipients.

Therefore, it would have been obvious for one skilled in the art, at the time of the present invention, to incorporate Soroker et al with the combination of Lytle et al, Powers, and Scheussler et al to generate an email transmission apparatus that can display a recipient list to the user before the transmission of the email. The motive behind this modification is to generate a secure transmission method; if an unauthorized user sees that the inputted sender address is automatically incorporated into the recipient list, then this may deter him/her from sending the illicit email.

3. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication Number 2002/0188683 by Lytle et al in view of U.S. Publication Number 2001/0034849 by Powers and U.S. Publication Number 2002/0112010 by Soroker et al.

Regarding claim 20, Lytle discloses an e-mail transmission apparatus comprising:

- sending address input means for receiving user input of a sending address; (**Paragraph 158, line 7 – paragraph 157, line 2 and table 1** illustrates a means for inputting the sending address.)
- receiving address input means for receiving user input of a receiving address; (**Paragraph 158, line 7 – paragraph 157, line 2 and table 1** illustrates a means for inputting the receiving addresses.)
- list creation means for creating a receiving address list that includes at least the receiving address input via the receiving address input means. (**Paragraph 168, lines 3-12** discloses emails are sent to recipients whose

email addresses are stored. The act of storing the recipient email addresses is, in essence, equivalent to the list creation means for creating a receiving address list mentioned in the present application.)

Lytle, however, does not consist of an address adding means which adds the inputted sender address to the receiving address list.

Powers, on the other hand, discloses in **paragraph 118** an apparatus that sends an email to the designated sender of the email. Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Lytle et al with Powers to form an apparatus that sends emails to not only the addresses in the inputted recipient list but also to the inputted address of the sender. The motivation behind incorporating Powers into Lytle et al is to devise a security method that inhibits impersonation of a user's identify as suggested in **Paragraph 117** of Powers.

Furthermore, Powers states in **Paragraph 118, Lines 6-8** that a "security mechanism" is used to verify the identity of sender, the mechanism constituting of the step of sending a copy of the email to the inputted sender address. The term "security mechanism" emphasizes the safeguarding involved in this process. In that, it would be difficult for the sender to delete the inputted sending email address from the recipient list. As a result, the address adding means adds the sending address to the receiving address list in a format such that it cannot be deleted from the receiving address list.

The above described combination of Lytle et al and Powers fails to describe a scenario wherein a display means for displaying the receiving address and sending address contained in the receiving address list is utilized.

Soroker et al, in **paragraph 38, Lines 1-5**, displays a list of all recipients. Therefore, it would have been obvious for one skilled in the art, at the time of the present invention, to incorporate Soroker et al with the combination of Lytle et al and Powers to generate an email transmission apparatus that can display a recipient list to the user before the transmission of the email. The motive behind this modification is to generate a secure transmission method; if an unauthorized user sees that the inputted sender address is automatically incorporated into the recipient list, then this may deter him/her from sending the illicit email.

Regarding claim 21, the above rejection of claim 20 is applicable in this instance as well since both claims discuss the same subject matter.

Claim Objections

1. Claims 6 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 6 and 16, the examiner's search did not yield a reference that "sends only a portion of data comprising the e-mail to the sending address in the receiving address list" in a secure email transmission system.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2625

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

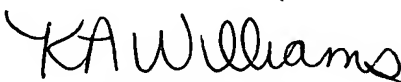
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashish K. Thomas whose telephone number is 571-272-0631. The examiner can normally be reached on 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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SUPERVISORY PATENT EXAMINER